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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,985	04/11/2001	Takashi Kinoshita	Q63469	8913

7590

02/03/2004

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WASHINGTON, DC 20037-3213

EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/829,985

Applicant(s)

KINOSHITA ET AL.

eb

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 12/18/2003. Applicants' amendments to claims 1, 5, 8, 9, 10, 12, 13, 15, 17 and 18, cancellation of claim 6 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' newly amended claims and arguments (Remarks, pages 6-7) are sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph, in section 3 of Paper No. 4. Also, Applicants' argument that Yamaoka's invention requires both layers B contain an elastomer (Remarks, page 8, second paragraph) is persuasive, as such the rejection under 35 U.S.C. 102(b) is withdrawn.

### ***Response to Amendment***

4. Claims 1, 4, 5, 7-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al. (US 5616420) in view of Arakawa et al. (US 5264281), substantially for the reasons set forth in section 4 of Paper No. 4, together with the following additional observations.

It is noted that the newly amended claim 1 now recites in part "wherein said layer A further comprises a thermoplastic elastomer and an inorganic filler, and said inorganic filler is at least one selected from the group consisting of talc and zeolite".

With respect to Applicants' response arguing that "to obtain a film whose stress relaxation has been improved resulting in relief of stimulation to the skin" (Remarks, page 9, top paragraph), the Examiner notes that "improved stress relaxation" is not present in any of the claims, and the Examiner again repeats (see Paper No. 4, pages 3-4) that Yamaoka teaches that the laminate can be used as substrates, i.e., backings, for adhesive tapes (column 1, lines 49-54); and Yamaoka also teaches that it is known art that a three-layer laminate film comprising an intermediate layer of an amorphous polyolefin and two outer layers of crystalline polypropylene, and such three-layer films are suitably usable for medical applications, etc. (column 1, lines 31-37). Yamaoka also teaches that the resin composition comprising a polyolefin and a thermoplastic styrene elastomer improves the flexibility, etc. (column 1, lines 45-47), i.e., the thermoplastic styrene elastomer inherently improves the softness and elasticity. Although Yamaoka lacks an express teaching to modify one of the outer polypropylene layers of the prior known art, on the side which is next to the skin (i.e., also next to the adhesive layer), with a thermoplastic elastomer to form a substrate (or backing) of a medical adhesive tape, it is noted that Arakawaet's invention is directed to an adhesive tape for medical use, and Arakawaet expressly teaches that the requisite of a base film for medical adhesive tapes is softness and elasticity, so as to be gentle to the skin, as evidenced by the teaching of the state of the art of (column 1, lines 36-60). As such, it would have been obvious to one of ordinary skill in the art of medical adhesive tape to modify the known art, taught by Yamaoka, to incorporate thermoplastic elastomer into the outer polypropylene layer which is on the side next to the skin, as taught by Arakawaet,

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motivated by the desire to improve the softness and elasticity of the laminate to be used as a backing of a medical adhesive tape.

With respect to Applicants' argument that amended claim 1 has a "well-balanced properties imparted by the presence of an inorganic filler, in particular, talc or zeolite and a thermoplastic elastomer in layer A", the Examiner notes that Yamaoka expressly teaches that the resin composition for the layer (A) may optionally contain additives, fillers, such as talc, clay, etc. Further, other thermoplastic resins, thermoplastic elastomers, rubbers, etc. can be optionally added. As such, in the absence of unexpected results, the improved properties to the laminate by aforementioned additives are believed to be either inherently disclosed, or an obvious optimization to one skilled in the art, motivated by the desire to improve the flexibility (or softness) of the laminate as a backing for a medical adhesive tape. The Examiner further notes that Applicants' argument "Yamaoka et al is silent on the specific effects, in particular, stress relaxation, by compounding a filler and a thermoplastic elastomer, as recited in the present claims. That is, the present invention provides unexpected results." (Remarks, page 10, third full paragraph) has been carefully considered, but is not persuasive. More particularly, it is noted that mono-layer backings in comparative examples 2 and 3 are provided as support for unexpected results, however, the Examiner notes that mono-layered backing is not considered to be fair examples of Yamaoka's invention, which teaches a multilayered laminate.

With respect to Applicants' contention that "even if a medical adhesive tape is prepared with the film having the constitution as described in Yamaoka et al as a base

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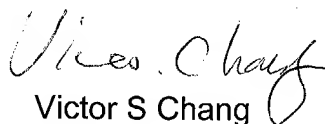
film, sufficient stress relaxation cannot necessarily be obtained" (Remarks, page 11, second paragraph), the Examiner notes that it is well settled that unexpected results must be established by factual evidence.

With respect to Applicants' argument that "Yamaoka does not teach ... wherein one of said layers B contains a thermoplastic elastomer and the other one of said layers B does not contain a thermoplastic elastomer" (Remarks, pages 11-12, bridging paragraph), the Examiner notes that Applicants' argument is not persuasive, since it assumes that an anticipation rejection, not an obviousness rejection, has been made. It should be noted that the properties of the instantly claimed invention are believed to be an obvious optimization over Yamaoka, as set forth above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.



Victor S Chang  
Examiner  
Art Unit 1771